

REMARKS

The Examiner has indicated in paragraph 6 that claim 7 would be allowable if rewritten in independent form to include the subject matter of the base claim and any intervening claim. In the foregoing amendment, claim 7 has been rewritten as an independent claim including the subject matter of claim 1, from which it previously depended. It is therefore submitted that claim 7 is now in order for allowance, along with claims 6, 8, 10, 11 and 19 which have been amended to depend from claim 7.

In paragraphs 2 to 3 of the Office Action, the Examiner has rejected claims 1, 2, 3, 8, 13, 14, 16, 17, 18 and 19 as anticipated by Design Patent No. D439, 214 of Cockerham. In the foregoing amendment, rejected claims 1, 17 and 18 have been canceled and claims 8 and 19 have been amended to depend from allowable claim 7. Claims 8 and 19 should therefore now be allowable. Claims 2, 3, 13 and 16 have all been amended to depend from claim 12, which is not rejected as anticipated by Cockerham, overcoming the rejection of these claims as anticipated by Cockerham. Claim 14 has been amended to depend from claim 9, which is also not rejected as anticipated by Cockerham. Reconsideration and reversal of the rejection of claims 2, 3, 8, 13, 14, 16, and 19 in paragraphs 2 and 3 is therefore respectfully requested.

In paragraph 4 of the Office Action, the Examiner has rejected claims 9 to 12 and 15 as obvious in view of Cockerham. Claims 10 and 11 now depend from allowable claims 7 and 8 and should therefore also be allowable. The rejection of the remaining claims listed in paragraph 4 is hereby traversed, and it is submitted that claims 9 and 12, which have been rewritten as independent claims in the above amendment, are fully distinguished from Cockerham, along with claims 2, 3, 13, 15 and 16 which all depend from claim 12, and claim 14 which depends from claim 9.

In rejecting claim 9, the Examiner contends that Cockerham clearly teaches indicia representing a human forearm, and contends that it would have been obvious to provide a shadow region as in claim 9 in the Cockerham device. This argument is hereby traversed. There is nothing in the teachings of Cockerham or any other cited

reference to suggest indicia representing a bent human forearm with the lower edge of the bent arm indicia spaced from the lower edge of planar member. In Cockerham, the lower edge of the indicia representing the bent arm is coincident with the lower edge of the planar member. Cockerham also does not describe or suggest indicia comprising a darker, shadow region extending from the lower edge of the bent arm indicia to the lower edge of the planar member.

In order to establish a *prima facie* case of obviousness using a single prior art reference, three criteria must be met, as stated in MPEP 2143. First, there must be some suggestion or motivation in the cited reference or the prior art as a whole to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all claim limitations. None of these criteria are met by the Cockerham reference in the case of claim 9. The indicia as defined in claim 9 have patentable significance in producing a 3-D effect when the sign is viewed, in order to better simulate a real human arm. The Examiner cannot dismiss elements of claim 9 which are completely lacking in the cited reference as "a design consideration", when absolutely no prior art reference has been cited which describes or suggests such elements. The proper test for obviousness is whether or not the claimed invention is shown or suggested by the prior art, not the Examiner's unsupported contention that differences between the claimed invention and the prior art are merely design considerations.

It is submitted that the indicia as claimed in amended claim 9 have a non-obvious functional relationship with the substrate or sign member, in that they are specifically positioned relative to the lower edge of the sign member so as to produce a desired three dimensional effect. No such indicia arrangement is described or suggested by Cockerham. Claim 9 is not obvious in view of Cockerham, and reconsideration and reversal of the rejection of this claim is respectfully requested. Claim 14 has been amended to depend from claim 9 and is distinguished from Cockerham for the same reasons as claim 9.

Amended claim 12, which is rewritten independently in the foregoing

amendment, is also not obvious in view of Cockerham. The Examiner's comments on claim 12 on page 4, lines 5 to 9, are not understood since this claim does not include any sleeve portion or indent. However, the Examiner did confirm the rejection of claim 12 in the communication of September 28, 2004. This rejection is incorrect. Cockerham has a cut off straight edge at the upper end of the upper arm portion of the sign, but has no such cut off straight edge at the upper end of the hand or fist portion of the sign. Instead, Cockerham's sign has complete fist. Due to the angle of the bent arm, even if there were a straight edge at the top of the fist, it could not be aligned with the upper straight edge of the upper arm portion without further unobvious modification of the sign shape.

In the invention as claimed in claim 12, the aligned upper straight edges of the hand portion and the upper arm portion of the sign (11 and 12 in Figure 1, for example) allow the sign to be positioned with the straight edges 11, 12 against the lower straight edge of a window 15 in a vehicle door, as indicated in Figures 4, 5 and 8 to 11. This allows the sign to better simulate the effect of a person hanging their arm out of an open vehicle window while resting their hand on the window edge. This advantage is described in paragraph 0025 on page 6 of the application. The Examiner is incorrect in stating that the invention claimed in claim 12 does not solve any problem or have any stated purpose. The aligned straight edges of the sign have the clearly stated purpose of allowing the sign to be positioned on a car door with the two straight edges adjacent the lower straight edge of the window, producing a desired visual effect.

Cockerham clearly does not describe or suggest all the claim limitations of claim 12, and specifically lacks any straight edge at the upper end of the hand or fist portion, let alone such a straight edge aligned with the straight edge of the upper arm portion. The reference also does not suggest any reason for modifying the sign to cut off a portion of the fist to provide a straight edge, or to modify the bent arm angle so such a straight edge could be aligned with the straight edge of the upper arm portion. Claim 12 is therefore clearly not obvious in view of Cockerham, and reconsideration and reversal of the rejection of this claim is respectfully requested.

Claims 2, 3, 13, 15, and 16 all now depend from amended claim 12, and these claims are also not obvious in view of Cockerham for the same reasons as claim 12, and additionally since these claims define other elements lacking from Cockerham. Referring to claim 15, not only does Cockerham not suggest any indicia on the upper face of the sign to indicate a sleeve, this reference also does not suggest an indent on the periphery of the sign to represent a hanging sleeve edge. This is not merely the addition of ornamental indicia to the upper face of the sign, but a change in the physical shape of the periphery of the sign to suggest a real sleeve which does not fit closely against the arm. The indent cut in the periphery of the sign therefore does have a purpose, which is to further enhance the "sleeve" effect and make the sign appear more like a real arm. It is submitted that such an arrangement is neither shown nor suggested by Cockerham.

It is therefore submitted that claims 9 to 12 and 15, along with claims 2, 3, 13, 14 and 16, are not obvious in view of Cockerham, and reconsideration and reversal of the rejection in paragraph 4 of the Office Action is respectfully requested.

In the first part of paragraph 5 of the Office Action, the Examiner has rejected claims 4 and 5 as obvious in view of Cockerham and U.S. Patent Application Publication No. 2004/0148830 of Baskerville. This rejection is also hereby traversed. Claims 4 and 5 now depend from amended independent claim 12, which is distinguished from Cockerham for the reasons stated above. The features of claim 12 lacking from Cockerham are also not described or suggested by Baskerville. Baskerville simply describes a rectangular "For Sale" sign made of magnetic sheet material. There is no suggestion in the combined teachings of these references to modify Cockerham to provide a cut-off straight edge at the upper end of the hand or fist part of the sign, let alone to modify the bent arm angle so that such an edge can be aligned with the straight edge at the upper end of the upper arm region. Reconsideration and reversal of the rejection of claims 4 and 5 based on Cockerham and Baskerville in paragraph 5 is therefore respectfully requested.

The Examiner goes on to reject claims 4, 5, 20 and 21 as obvious in view of

Cockerham combined with U.S. Patent No. 6,041,534 of Buhler. This rejection is also hereby traversed. Claims 4 and 5 depend from amended claim 12, and the features of claim 12 lacking from Cockerham are similarly lacking from Buhler. Again, the magnetic car door signs of Buhler are rectangular and are not intended to be positioned against the lower edge of the car door window. It is therefore submitted that claims 4 and 5 are not obvious in view of Cockerham and Buhler, and reconsideration and reversal of the rejection of these claims is respectfully requested.

Claims 20 and 21 depend from amended claim 9, and the features of claim 9 lacking from Cockerham are also lacking from Buhler. Neither of these references describes or suggests a sign comprising a flat planar member with a peripheral shape representing at least part of a human arm and indicia on the upper face of the sign including a lower edge of the bent arm spaced from the lower edge of the sign, and a shadow region darker than the remainder of the upper face extending from the lower edge of the arm indicia to the lower edge of the sign.

It is therefore submitted that claims 4, 5, 20 and 21 are not obvious in view of Cockerham and Buhler, and reconsideration and reversal of the rejection of these claims is respectfully requested.

In the last paragraph on page 5 of the Office Action, the Examiner has rejected claims 6, 20 and 22 as obvious in view of Cockerham combined with U.S. Patent No. 6,367,182 of Olson. This rejection is also hereby traversed. Claim 6 now depends from allowable claim 7, avoiding this rejection. Claims 20 and 22 depend from amended claim 9, which is distinguished from Cockerham for the reasons stated above in connection with the rejection in paragraph 4. The features of claim 9 lacking from Cockerham are also completely lacking from Olson, which simply describes attachment of a temporary license in the form of a rectangular plate to the inner surface of a vehicle window using suction cups. It is therefore submitted that claims 20 and 22 are not obvious in view of Cockerham and Olson, and reconsideration and reversal of this rejection is respectfully requested.

It is believed that the foregoing amendment and argument overcomes all grounds

of objection and rejection, and that all of the claims remaining in this application, specifically claims 2 to 16 and 19 to 22, should now be in order for allowance. Early notice to this effect is earnestly solicited. If there are any outstanding objections which could be dealt with by means of a telephone interview, the Examiner is encouraged to contact the undersigned representative.

Respectfully submitted,

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